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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,106	10/22/2001	Heinz Wolleb	EL/2-21812/A/CONT/DIV	5985

324 7590 11/10/2003

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PATENT DEPARTMENT
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EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 11/10/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,106

Applicant(s)

WOLLEB ET AL.

Examiner

Martin J Angebrannt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003 and 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-23 and 204 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12, 14 and 15 is/are allowed.
- 6) ☐ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) 2-4, 13 and 16-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/365471.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The response provided by the applicant has been read and given careful consideration. Responses to the arguments and amendments of the applicant are presented after the first rejection to which they are directed. Rejections of the previous office action, not repeated below are withdrawn based upon the amendments to the claims and arguments. The double patenting rejection is withdrawn based upon the restriction in the parent application in the third action, on 3/22/2003.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3 Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995), in view of Kimura et al. EP 0811506 and Itoh et al. '067.

Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) teach the compound shown in the lower portion of Scheme 1, on page 1715. The octylester linkage uses the carbonyl, oxygen and methylene moieties listed in claim 1. The spectroscopic properties are disclosed including the absorption in the 600-800 nm region in figure 1. a drop fo the compounds is spin coated on a rotating glass slide. The examiner holds that this is inherently able to record information. Figure 2 shows the spectrum of this film.

Kimura et al. EP 0811506 teaches the formation of optical recording media in example1, including the measurement of absorption properties. Example 2 includes the reflective layer and protective layer in the structure. The addition of the moieties including the ferrocyanine moieties

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increases the light resistance of the media. (page 7). The use of these with semiconductor lasers is disclosed. The use of glass or thermoplastic resins, such as polycarbonate or acrylic resins, as an optical recording medium substrate is disclosed. (16/24-30)

Itoh et al. '067 teaches that desirable optical recording media using phthalocyanine dyes absorb in the 700-900 nm range and are useful with semiconductor lasers. (2/34-45). The use of 780 nm semiconductor lasers is disclosed at least in examples 1 and 2. The use of these in liquid crystal matrices is also disclosed. The use of a polycarbonate as a substrate material is disclosed with respect to example 49 (29/62-63)

Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) does not disclose optical recording media with structure beyond a simple film coated on a glass slide. It would have been obvious to use the metallocenyl phthalocyanine dye disclosed by Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) in place of the metallocenyl phthalocyanine dye used in the examples of Kimura et al. EP 0811506 with a reasonable expectation of gaining the advantages of improved stability and light resistance disclosed therein and would have been further moved to do so based upon the absorption properties disclosed by Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) which are within the range disclosed as desirable by Itoh et al. '067, who also establishes the linkage between liquid crystal materials and optical recording media. Further it would have been obvious to modify the result of the above combination to use polymeric substrates, such as those disclosed by Kimura et al. EP 0811506 and Itoh et al. '067, in place of the glass substrate of Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995), in view of the disclosure of the equivalence of glass and polymeric materials as optical recording media substrates by Kimura et al. EP 0811506.

The applicant argues that the Cook reference does not describe these compounds used in an optical recording medium. The applicant missed the point that the layer containing the compound formed in the glass slide is inherently an optical recording medium within the bounds of the claims. The specification lists glass as an appropriate substrate material on page 18 in the next to last line. The use of spin coating is described in the last paragraph of page 20. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The teaching of Kimura establishes that when using a ferrocenyl-phthalocyanine for optical recording, one should expect increased resistance to degradation by light and the teachings of the Itoh reference establishes the analogous nature of optical element such as optical recording media and liquid crystal displays. While the solubility issue raised by the applicant might preclude using the ferrocenyl-phthalocyanine dyes of Kimura with liquid crystals due to solubility issues. The solubility of the dyes of Cook would be expected to be more than soluble for optical recording media applications. Quite simply the applicant's argument is backwards. The issue of the sulfonic acid linkage is irrelevant as the issue is the use of the dye of Cook, unadulterated, in optical recording media, not some bizarre hybrid of the dyes of Cook and Kimura. The rejection stands.

In response to the arguments of 09/09/03, which replace the other responses, the examiner the argument of the use of impermissible hindsight fail to account of the linkage between phthalocyanine compounds in liquid crystal materials and optical recording materials by Itoh reference and that materials useful in one would be useful in the other, particularly for

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phthalocyanine compounds. The arguments of the applicant also fail to account for the spectroscopic information on the record. Were the spectral properties not shown in Cook, the applicant would be on solid ground, but the presence of this information would not be so neglected by one of ordinary skill in the art. The arguments at the bottom of page 17 of the response that the addition of the ferrocene does not improve light resistance is entirely without merit and misleading. The examiner notes that dyes f, g, j, k, and n all have light resistance of at least 90%, whereas compounds o and p, which lack the ferrocene are 74 and 81%. Comparing within the compounds bearing the ferrocene is just poor analysis. In tables 2 and the comparative example in table 3, the BLER rate is much higher for the non-ferrocene compounds as is the drop in the IIT modulation degree. Therefore the applicant's analysis is flawed and the arguments refuted. The rejection stands.

4 Claims 2-4,13 and 16-23 are objected to as allowable over the prior art of record, but dependent upon rejected claims

5 Claim 12, 14 and 15 are allowed.

6 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 703-308-4397.

The examiner can normally be reached on Mondays-Thursday and alternate Fridays.

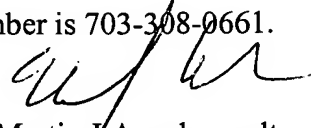
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Martin J. Angebranndt
Primary Examiner
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November 5, 2003